REMARKS

The Office action mailed on 31 March 2004 (Paper No. 5) has been carefully considered.

Specification And Drawings

The specification and drawings have been corrected to correct minor errors and improve form. No new matter has been introduced.

Status of the Claims

Pursuant to 37 C.F.R. §1.173(c), claims 1 through 46 are pending. By this Amendment, no claims have been amended and claims 31 through 46 are newly presented in accordance with Applicant's originally filed reissue Declaration, to obtain broader coverage than is provided by the original grant.

Support For Claim Changes

Pursuant to 37 C.F.R. §1.173(c), independent process claim 31, together with claims 32 through 34 depending thereon, apparatus claim 35 together with claims 36 through 38 depending thereon, and process of manufacture claim 39 together with claims 40 through 42 depending thereon, are supported by the discussion set forth in Applicant's Summary of the Invention appearing in column 2, beginning with line 30 and extending through line 49. Dependent claims 32, 36 and 40 are illustrated, by way of example, steps 52 and 53 of amended Figure 5, claims 33, 37 and 41 are illustrated by steps 52 and 53 and claims 34, 38 and 42 are illustrated by step 55 in Figure 5.

Independent claim 43, together with dependent claim 44, are illustrated in original Figure 5, as well as amended Figure 5.

Independent claim 45 is illustrated by original Figure 6 and newly submitted Figure 6, including steps 61, 62; 63; 64; 65; 68 and 69; and 66. Dependent claim 46 is illustrated

in Figure 6, steps 67, 62 and 63.

Substitute Declaration

The Examiner has objected to the declaration for lack of information about the foreign priority application on which the present application is based, and required submission of supplemental declaration under 37 C.F.R. §1.175(b)(1).

Claims 1 through 30 were rejected as being based upon a defective reissue declaration under 35 U.S.C. §251. The Examiner stated however, that claims 2, 4 and 5 would be allowable if rewritten in independent form including all of the limitations of the rejected base claim and any intervening claims, and if the rejection under 35 U.S.C. §251 is overcome. The Examiner further stated that claims 6 through 29 would be allowable if the rejection under 35 U.S.C. §251 is overcome.

Identification of Foreign Priority

The Examiner asserted that the Declaration must identify the foreign application on which priority is claimed, and that "such claim must be repeated in the reissue application in order to retain priority to the earlier effective filing data [*sic* date?]". This application was filed with a "data sheet."[1] Applicant has confirmed with the SPRE of Tech 2600, and with Mr. Ken Wiener in the Office of Patent Legal Administration, that the filing of a data sheet with the application satisfies the need for repetition of the clams for foreign priority. This is in conformance with 35 U.S.C. §1.119(a)-(d) and 37 CFR §§1.55 and 1.63. As is explained in §1417 of the *Manual of Patent Examining Procedure*, 8th Ed., Rev. 1, a claim for foreign priority:

> "made pursuant to 37 CFR §1.55, the oath or declaration must identify the foreign application for patent or invertors' certificate on which priority is claimed unless supplied on an application data sheet"

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[1]   *Manual of Patent Examining Procedure*, 8th Ed., Rev. 1, §1417, p.1400-36.

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filed pursuant to 37 CFR §1.76. A second data sheet is filed with this correspondence. Accordingly, there is no deficiency in either the Declaration or Applicant's repetition of the claim for the effective foreign priority date.

Defective Declaration - Arose Without Any Deceptive Intention

Claims 1 through 30 were rejected as based upon a defective reissue application, based upon the Examiner's assertion that the application failed to assert that the errors "arose without any deceptive intention on the part of the Applicant." The Examiner's attention is respectfully invited to page 2 of the Reissue Application Declaration by the Inventor, which states:

> "All errors corrected in this reissue application arose without any deceptive intention on the part of Applicant."

Accordingly, withdrawal of this rejection is respectfully requested.

Defective Declaration, Statement of Lost of Inaccessibility

Claims 1 through 30 were also rejected under 35 U.S.C. §251 based upon the Examiner's assertion that Applicant had neither surrendered nor explained the loss or inaccessibility of original grant. Applicant respectfully traverses this rejection, and invites the Examiner's attention to page 2 of the Reissue Application Declaration by the Assignee, which states,

> "All errors corrected by this reissue application arose without any deceptive intent on the part of the Applicant."

> "I offer to surrender the original grant of the patent, but that patent is lost or has become unavailable."

In view of the offer and the explanation for the inability of the Assignee to surrender the original grant, the Declaration satisfies 37 C.F.R. §1.178 and there is no basis for

maintaining this rejection under 35 U.S.C. §251. Its withdrawal is respectfully requested.

Rejection under 35 U.S.C. § 102(b)

Claims 1, 3, and 20 were rejected under 35 U.S.C. §102(b) for alleged anticipation by Kimoto, U.S. Patent No. 4,509,154. Applicant respectfully traverses this rejection for the following reasons. This same discussion applies to newly presented claims 31 through 46.

Kimoto '154 discusses a data recording and reproducing apparatus and process, in which a track pitch is first computed by "track pitch computing means 18" from the number data received from an external central processing unit for one of the tracks upon a disk, and a scale value is computed by a "scale translator 17" from "the track pitch obtained" during the previous step of computing the track pitch. Subsequently, the recording head is moved in accordance with the "scale value obtained" and the number of the track to which the recording head has been moved is read. Kimoto '154 documents in column 1, line 38, and again in column 1, lines 44 and 45, the art recognized problem of "access time" that has long plagued the art, and recognizes the need to shorten "access time of the head".[2]

A. To Anticipate a Claim, the Reference Must Teach Every Element of the Claim

The sole reference relied upon to support the rejection of claims 1, 3 and 30 fails to teach every element of each of these claims. Under 35 U.S.C. §102(b),

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *Manual of Patent Examining Procedure*, 8th edition, Rev. 1. Fed. 2003.

Applicant's claims 1, 3 and 30 all define process steps of "jumping said pickup ... [and] counting the number of tracks detected during said jumping". In support of this rejection,

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[2]   Kimoto '154, column 1, line 44, 45.

the Examiner asserted that Kimoto '154 teaches in its step 34, a step of "jumping the pickup 3 in a predetermined direction A across the tracks" and "counting the number of tracks detected during the jumping step" using counter 16 in step 35. The Examiner has misinterpreted the teachings of Kimoto '154. Kimoto '154 expressly teaches a "position signal processing circuit 14", and describes the position signal processing circuit 14 as having:

> "A pulse generator 15 for generating a position pulse in accordance with the two detection signals which have different phases; and a counter 16 for counting up or down in accordance with the pulse from the pulse generator 15." Column 3, lines 7-12.

The Examiner's attention is invited to column 2, beginning with line 66, which teaches:

> "An optical scale 12 is fixed on the movable portion of the linear motor 11. A detection section 13 detects the position of the optical scale 12. A detection section 13 produces two detection signals which have different phases upon movement of the optical head 3 in accordance with the overlap grading type detection method."

These "two detection signals" generated by detection section 13 are the "two detection signals which have different phases" mentioned in column 3, line 10, that are applied to pulse generator 15 which, in turn, generates the "position pulse in accordance with" those two detection signals mentioned in column 3, lines 8-10, that results in the "count" made by "counter 16." This "count" is not the "number of tracks jumped" as defined by claims 1 and 30, but is a count based on the grating of optical scale 12.

The Examiner's confusion appears to arise from the operation of counter 16 which counts the position pulse generated by pulse generator 15 in response to the two detection signals having different phases generated "upon movement of optical head 3 in accordance with the overlap grading type detection method" discussed in column 3, lines 1-4. The teachings of Kimoto '154 are singularly devoid of any teaching, suggestion or inference of

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the Examiner's step of "counting" in step 35, "the number of tracks detected during the jumping step" performed during step 34; there is no equivalency between the "overlap grading type detection method" taught by line 4 of column 3 of Kimoto '154 and Applicant's "counting the number of tracks detected." Recognizing that "each and every element" set forth in claims 1, 3 and 30 is not found in Kimoto '154, these claims are not anticipated in accordance with §2131 of the *MPEP* (8th Edition, Rev. 1). Withdrawal of this rejection is respectfully requested.

**B.   To Show Anticipation, The Identical Invention Must
         Be Shown In As Complete Detail As Is Contained In
         The Claims.**

Rejected claims 1, 3 and 30 all define process steps of "counting the *number of tracks detected* during said jumping step". In contradistinction, the process performed in Kimoto '154 detects nothing used in its disk calibration and search, but instead teaches that:

> "A digitizer 20 converts the analog signal from the photodiode
> 10 into a binary signal [and] ... the control section 21 produces
> a track jump pulse in accordance with difference between the
> track number data from the digitizer 20 ... ." Column 3, lines
> 30-32 and 40-42.

The "track number data from the digitizer 20" is data that is read from the track by optical head 3 for a specific track, but is not a count of "the number of tracks detected" as defined by claims 1, 3 and 30. Kimoto '154 teaches that this "track number" is important because the "track number" is applied in the second equation (column 3, lines 27, 28) to update the "track pitch" by "track pitch computation means" 18.

As shown in step 36 in Figure 2A of Kimoto '154, the "track number" is determined by the signal reproduced from the disk by optical head 3; no count of tracks is taught. Consequently, absent the teaching or suggestion, and recognizing the absence of any need in Kimoto '154 to use Applicant's count of "the number of tracks detected", Kimoto '154 fails to show "the identical invention ... in as complete detail as contained in" rejected claims

1, 3 and 30, as is required by §2131 of the *MPEP* in order to maintain an anticipation rejection under 35 U.S.C. §102(b). *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Withdrawal of this rejection is therefore required.

C.   Kimoto '154 Fails to Make a *Prima Facie* Showing of Anticipation

1. Kimoto '154 Lacks A Step Of "Making A "count[of] The Number Of Tracks Detected During Said Jumping Step"

Claims 1, 3 and 30 define Applicant's steps of,

"count the number of tracks detected during said jumping step"

and

"calculating a *unit track number* of the disk per a single movement of a driving means for jumping the pickup."

In particular embodiments, this may be practiced as simply a unitization of the number of tracks jumped per pulse. Kimoto '154 however, neither teaches nor requires calculation of the unitization of the number of tracks jumped, but rather relies upon the "scale value track number" read by detection section 13 from optical scale 12. This "scale value track number" gauges movement of linear motor 11, as represented by the grading of optical scale 12 which is mounted on linear motor 11, rather than upon disk 1.[3]

It is important to note that the "count" taught by Kimoto '154 is a count made by "counter 16", of the movement of optical scale 12 mounted on linear motor 11; Kimoto '154 nowhere recognizes Applicant's process of "counting the number of tracks detected during said jump", as defined by claims 1, 3 and 30. Moreover, there is no equality taught by Kimoto '154 between its count of scale graduations make by counter 16 and Applicant's count of "the number of tracks detected", primarily because Kimoto '154 counts graduations of optical scale 12 and makes no count of the tracks jumped on disk 1, and secondarily,

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[3]   See Kimoto '154, column 2, lines 66-69 and column 3, lines 1-4.

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because Kimoto '154 detects no tracks during its movement of optical head 3 in steps 34, 35 and 36. [4]

2. Kimoto '154 Lacks A Step Of "Positioning A Data Pickup Across To A First Position" In Step 34

In support of the rejection of claims 1, 3 and 30, Paper No. 5 erroneously asserts that:

> "Kimoto discloses ... positioning a data reading pickup 3 across to a first position on a disk 1 and jumping the pickup in a predetermined direction A across tracks on the disk 1 (step 34)."

In actuality, the passage quoted from Paper No. 5 appears nowhere in Kimoto '154, and is copied substantially *verbatim* from Applicant's claims 1 and 30. Moreover, Kimoto '154 lacks teaching of Applicant's step of "jumping of said pickup in a predetermined direction across tracks on said disk"; Kimoto '154 specifies only direction of movement, but not a destination to any specific track, because the "track number data to be accessed by address data is supplied from a CPU (not shown)" [5] and that "track number data" is then, in step 33, translated into a "scale value" by "scale translator" 17; Kimoto '154 is driving linear motor 11 in correspondence with this "scale value" in his effort to address the art recognized problem by shortening "access time of the head."[6] Kimoto '154 never states where optical head 3 begins its movement or where optical head 3 is positioned prior to its initial movement in step 34. In the calibration and search scheme taught by Kimoto '154, the position of optical head 3 prior to its initial movement is not relevant to the practice of Kimoto '154. Consequently the single movement of optical head 3 "to direction A" spanning

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[4]   "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior reference." *Manual of Patent Examining Procedure*, 8th edition, Rev. 1. Fed. 2003.

[5]   Kimoto '154, col. 3, lines 59, 60.

[6]   Kimoto '154, col. 1, lines 44, 45.

steps 34, 35 and 36 of Kimoto '154 can not be read as teaching both Applicant's (i) *"positioning* a data reading pickup across *to a first position* on a disk" and also read as (ii) *"jumping* the pickup in a predetermined direction across tracks".[7] Moreover, how may Kimoto '154 be read as anticipating Applicant's step of "positioning a data reading head across to a first position" when Kimoto '154 itself never uses this phrase? Furthermore, Paper No. 5 completely ignores that Kimoto '154 teaches the step of making a "jump [of] optical head [3] to direction A" in step 41, not in step 34 as is asserted by Paper No. 5, with that "jump" occurring wholly subsequent to its arithmetic operations. Therefore, Kimoto '154 fails to anticipate claims 1, 3 and 30.

3. Kimoto '154 Lacks Both Steps Of "Positioning A Data Pickup Across To A First Position" And "Jumping Said Pickup ..." In Step 34

Paper No. 5 is incorrect in asserting that Applicant's step of "positioning a data reading pickup 3 across to a first position on a disk" and "jumping said pickup in a predetermined direction across tracks on said disk" has been anticipated by step 34 of Kimoto '154, because Kimoto '154 does not teach both "positioning a data reading pickup across to a first position" and "jumping said pickup ..." but simply initiates movement of optical head 3 in step 34 and stops that movement in step 36. In effect, Kimoto '154 either *positions* optical head 3 or, alternatively, *jumps* optical head 3, but the single movement of optical head 3 in steps 34, 35 and 36 does not anticipate both steps of "positioning ... to a first position" and also "jumping ... in a predetermined direction."[8] Consequently, Kimoto '154 can not be read as anticipating claims 1 and 30.[9]

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[7] "A claim is anticipated **only if** each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior reference." *Manual of Patent Examining Procedure*, 8th edition, Rev. 1. Fed. 2003.

[8] Claims 1 and 30, first and second paragraphs.

[9] Recall that under 35 U.S.C. §102(b), "a claim is anticipated **only if** each and every element as set forth in the claim is found, either expressly or inherently described, in

4. Kimoto '154 Lacks Applicant's Step Of "Calculating A Unit Track Number Of The Disk Per A Single Movement Of A Driving Means" In Step 38

Paper No. 5 asserts that:

> "Kimoto discloses ... *calculating* a *unit track number* ... per a single movement of a driving means 11 for jumping the pickup ... (... step 38)." [10] (Emphasis added)

Kimoto '154 in fact states something quite different from what is asserted by Paper No. 5, namely that two operations are performed in step 38; despite this, Kimoto '154 neither describes nor suggest Applicant's step of *calculating* a *unit track number*.

In the first operation, Kimoto '154 teaches that "the track pitch computation section 18 computes a track pitch in accordance with the current track number and the scale number of the counter 16. More particularly, the track pitch is obtained by the arithmetic operation:

'track pitch = count × scale pitch (32μm) ÷ track number.'"[11]

None of these values (*i.e.*, neither "track pitch", "count", "scale pitch" nor "track number") represents Applicant's *unit track number*. Where in this record is the evidence of anticipation if Kimoto '154 fails to even write the term *unit track number*?

In the second operation performed in its step 38, Kimoto '154 states that "the control section 21 produces the *correction signal* to the track pitch computation section 18 in step 38,"[12] and that "control section 21 also produces a correction signal to the track pitch computation section 18"[13] when the "difference between the track number data from the

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a single prior reference." *Manual of Patent Examining Procedure*, 8th edition, Rev. 1. Fed. 2003.

[10]   Paper No. 5, page 2.

[11]   Kimoto '154, col. 4, lines 16-22.

[12]   Kimoto '154, col. 4, lines 14-16.

[13]   Kimoto '154, col. 3, lines 44-46.

digitizer 20 and the target track number data ..."[14] is more than "100"."[15]

Neither operation either requires or suggests Applicant's *unit track number*. There is no basis in Kimoto '154 to support the averment of anticipation.

5. Kimoto '154 Lacks Applicant's Step Of "Calculating A Unit Track Number Of The Disk Per A Single Movement Of A Driving Means For Jumping The Pickup" In Step 38

Basically, Kimoto '154 follows an incremental scheme of calculate the next move of its optical head 3, and then move optical head 3, without conducting any process steps during the movement, and without subsequently performing any calculations in reliance upon any measurements made during the movement. As was earlier noted, in support of the rejection of claims 1, 3 and 30, Paper No. 5 asserts that:

> "Kimoto discloses ... *positioning* a data reading pickup 3 across to a first position on a disk 1 and *jumping* the pickup in a predetermined direction A across tracks on the disk 1 (step 34) ... [and] *calculating* a *unit track number* ...and track pitch of the disk 1 per a single movement of a driving means 11 for jumping the pickup ... (... step 38)." [16] (Emphasis added)

Even after ignoring *arguendo* that (i) this passage taken from Paper No. 5 nowhere appears in Kimoto '154, but was copied substantially verbatim from rejected claims 1 and 30, and after ignoring *arguendo* that (ii) rather than teaching both *positioning* and *jumping* of optical head 3, Kimoto '154 instead teaches in steps 34, 35 and 36 a single movement of optical pickup 3 that is interrupted in step 36 and resumed after step 40, and also ignoring *arguendo* that (iii) Kimoto '154 nowhere teaches calculation of a *unit track number*, a thorough reading of Kimoto '154 establishes that Paper No. 5 is factually erroneous because Kimoto '154 teaches no movement of any sort by optical head 3, regardless of whether Paper No. 5

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[14]   Kimoto '154, col. 3, lines 41-43.

[15]   Kimoto '154, col. 3, lines 46, 47.

[16]   Paper No. 5, page 2.

characterizes such movement as "positioning" or as "jumping",[17] between when Kimoto '154

performs its movement during steps 34, 35 and 36 in conformance with the "scale value"

determined in step 33, and until well after performance of its step 40 to:

> "translate α into scale value and increase output of scale translation section."

Prior to its move during steps 34, 35 and 36, Kimoto '154 undertook in its step 33, to:

> "translate desired track into scale value in accordance with track
> pitch from track pitch from track pitch computation section,"

and that Kimoto '154 continues that movement of optical head 3 initiated in its step 34

through steps 35 and 36, where Kimoto '154 then acts to "stop optical head and determine

track number". In simple terms, an arithmetic function is performed by the circuit shown in

Figure 2B of Kimoto '154, that arithmetic function[18] is performed to control the subsequent

movement of optical head 3 in either a repetition of steps 34-36 or 41,[19] or alternatively, in

step 41. After its "jump" in step 41, Kimoto '154 either goes into a record mode or reverts

to an error mode.

Consequently, it is impossible for Kimoto '154 to be read as anticipating Applicant's

step of:

> "calculating a unit track number of the disk *per a single*
> *movement* of a driving means for jumping the pickup"[20]

when Kimoto '154 first translates in step 33 the "desired track into [a] scale value in

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[17]   Only later, in its step 41, does Kimoto '154 undertake to "jump optical head" 3.

[18]   That arithmetic function is defined in step 38 of Kimoto '154, and is completed before the subsequent movement of optical head 3 in either a repetition of steps 34, 35 and 36 or in the jump during step 41..

[19]   Whether that subsequent movement is in accordance with steps 334, 35 and 36 or is pursuant to step 41, depends upon the determination of relative position of the optical head 3 made in step 39.

[20]   Claims 1 and 30, fourth paragraph.

accordance with track pitch" and only thereafter does Kimoto '154 perform its steps 34 and 35 in order to "move optical head" 3, and when Kimoto '154 first performs its track pitch computation in step 38 before moving optical head 3 in either steps 34-36 or alternatively, in step 41. That is, the calculations performed by Kimoto '154 are prospective in preparation for a subsequent movement, rather than partially retrospective calculations based upon a previously initiated movement; it is impossible to read these iterations of move and stop interrupted by translations of differing values into scale values, as Applicant's steps of:

> "Kimoto discloses ... *positioning* a data reading pickup 3 14 across to a first position on a disk + 16 and *jumping* the pickup in a predetermined direction A across tracks on the disk + 16 (step 34) ... [and] *calculating* a *unit track number* ...and track pitch of the disk + 16 per a single movement of a driving means 11 for jumping the pickup ... (... step 38)." [21] (Emphasis added, and deletions struck-out and insertions underlined to conforms to rejected claims 1, 3 and 30).

Consequently, there is no basis for asserting that claims 1, 3 and 30 have been anticipated by Kimoto '154.

6. Kimoto '154 Lacks A Determination Of A "Unit Track Number" In Step 38

Again ignoring *arguendo* that Kimoto '154 nowhere teaches calculation of a *unit track number*, any process of making a determination of a "unit track number" which may be performed by step 38 of Kimoto '154 can not be read as anticipating Applicant's "per a single movement of a driving means for jumping the pickup" because the jump of the pickup is either repeatedly performed in steps 34, 35 and 36, or is completed in step 41, depending upon the respective determinations of steps 37 and 39. As demonstrated by the earlier excerpts from Kimoto '154,[22] the two operations of step 38 neither require nor suggest utility for Applicant's *unit track number*. How may Kimoto '154 be said to anticipate Applicant's

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[21] Paper No. 5, page 2.

[22] Kimoto '154, col. 3, lines 40-47 and col. 4, lines 14-22.

calculation of a *unit track number*, when Kimoto '154 does not use this phrase?

Accordingly, neither Applicant's calculation of a unit track number nor Applicant's sequence of *calculating a unit track number* on the basis of the detection made *during said jump* are found in Kimoto '154. [23] This rejection therefore fails to make a *prima facie* showing of anticipation, and may not be maintained.

7. Paper No. 5 Artfully Ignores An Absence In Kimoto '154 Of Any Disclosure Of A Relationship Between "A Unit Track Number" And "An Average Pitch"In Steps 34, 35 And 38

Applicant's step of "calculating a *unit track number* per a single movement" does not stand in isolation; that *unit track number* is used in Applicant's step of "calculating an *average pitch* ... in accordance with the calculated *unit track number*". Returning once again to the assertion of Paper No. 5 that:

> "Kimoto discloses ... *calculating* average *track pitch* of the disk
> 1 per a single movement of a driving means 11 for jumping the
> pickup ... (track pitch computation 18; step 38)", [24] (emphasis
> added),

and again ignoring *arguendo* that rather than teaching both *positioning* and *jumping* of optical head 3, Kimoto '154 instead teaches a single movement of optical pickup 3, and continuing to ignore *arguendo* that Kimoto '154 nowhere teaches calculation of a *unit track number*, rejected claims 1 and 30 define a step of "calculating an *average pitch* between the tracks in accordance with the calculated *unit track number*."

First, this assertion, and the rejection under 35 U.S.C. §102(b) based upon this assertion, are false and specious. Correction of Paper No. 5 to accurately read:

> "Kimoto <u>fails to</u> discloses ... *calculating* <u>an</u> average *track pitch*

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[23]   As earlier explained, the arithmetic function performed by the circuit illustrated in Figure 2B of Kimoto '154, namely to "translate desired track into scale value" is performed in step 33, before the movement of its optical head 3 in step 34."

[24]   Paper No. 5, page 2.

of the disk 1 per a single movement of a driving means 11 for jumping the pickup in accordance with the calculated *unit track number* ... (track pitch computation 18; step 38)", [25] (deletions indicated by strikeout, corrective insertions from claims 1, 3 and 30 underlined, and emphasis added).

Such action is respectfully requested.

Second, and contrary to the assertion set forth in Paper No. 5, Kimoto '154, in its step 38, actually "compute[-s] *track pitch* in accordance with *current track number* and *scale number* ... ." Not only does Kimoto '154 fail to teach any *unit track number*, but Kimoto '154 expressly teaches a step of determining a *track pitch* on the basis of different values than Applicant's *unit track number*.[26] In short, Kimoto '154 fails to teach the relationship between an *average pitch* and the *unit track number* defined by claims 1, 3 and 30. This failure negates the assertion of anticipation of claims 1, 3 and 30.

D.   The Criteria Set By 35 U.S.C. §102(b) To Establish Anticipation Have Not Be Met

1. Paper No. 5 Improperly Rejects Claims 1, 3 and 30 As Anticipated By Applicant's Own Teaching About Positioning A Data Reading Pickup Across To A First Position

First, 35 U.S.C. §102(b) states that a "person shall be entitled to a patent unless the *invention* was patented or described in a printed publication ... ." Paper No. 5 incorrectly states that:

> "Kimoto discloses a ... method, comprising: positioning a data reading pickup 3 across to a first position on a disk 1 and jumping the pickup in a predetermined direction A across tracks

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[25]   Paper No. 5, page 2.

[26]   Recall once again that under 35 U.S.C. §102(b), "a claim is anticipated **only if** each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior reference." *Manual of Patent Examining Procedure*, 8th edition, Rev. 1. Fed. 2003.

on the disk (step 34). [27]

A thorough reading of Kimoto '154 shows that the excerpted passage appears nowhere in Kimoto '154, but is a paraphrase from the text of Applicant's claims 1 and 30. The evidence before the Commissioner shows that in its step 34, Kimoto '154 teaches "move optical head [3] to direction A" and only subsequently, after stopping this movement in step 36, does Kimoto '154 in step 41 teach a step of "jump optical head." The excerpt from Paper No. 5 has no base in Kimonto '154, and effectively rejects claims 1, 3 and 30 as anticipated by their own language. This is establishes that Paper No. 5 has not met the statutory criterion which must be met before claims 1 and 30 are rejected, namely that "the invention" be "patented or described in a printed patent."

2. Paper No. 5 Improperly Rejects Claims 1, 3 and 30 As Anticipated By Applicant's Own Teaching About Positioning A Data Reading Pickup Across To A First Position

Second, in step 34, Kimoto '154 simply "move[-s] optical head [3] to direction A", and nowhere teaches or suggest moving optical head 3 "across to a first position on a disk ... ."[28] 35 U.S.C. §102(b) sets as one criterion for anticipation, that "the invention [defined by the rejected claim] was patented or described in a printed publication." Kimoto '154 expressly teaches that,

> "In step 34, the optical head is moved in the direction A, and the program advances to step 35."[29]

The language appearing in the earlier excerpt from Paper No. 5, namely "positioning a data reading pickup 3 *across to a first position on a disk*" which appears nowhere in Kimoto '154, was copied from the first paragraph of claims 1 and 30. This is additional evidence that Paper No. 5 has not met the statutory criterion which must be met before claims 1 and 30 are

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[27]   Paper No. 5, page 2.

[28]   Claims 1, 3 and 30, first paragraph.

[29]   Kimoto '154, column 4, lines 2 and 3.

rejected as anticipated, namely that "the invention" be "patented or described in a printed patent."

3. Paper No. 5 Improperly Rejects Claims 1, 3 and 30 As Anticipated By Applicant's Own Teaching About Counting The Number Of Tracks

Third, Paper No. 5 erroneously asserts that,

> "Kimoto discloses ... counting the number of tracks detected during the jumping step (counter 16, step 35)."

Further reading of Kimoto '154 reveals that Kimoto '154 nowhere either mentions or suggests in its step 35 either "counting the number of *tracks*" or "counting the number of tracks detected" or "counting the number of tracks detected during the jumping step"; this language was copied from the third paragraph of rejected claims 1 and 30. In point of fact, in step 35, Kimoto '154 states that,

> "the scale value from the scale translation section 17 is compared by the comparator 19 with the count of the counter 16", [30]

and expressly states it relies upon "the overlap grating type detection method" [31] of optical scale 12 to gauge movement of linear motor 11; Kimoto '154 has neither reason to practice, nor teaching of, Applicant's step of "counting the number of tracks" as is erroneously stated in Paper No. 5. This error of using the precise language of Applicant's claim in an erroneous effort to show anticipation serves as further evidence that Paper No. 5 has not met the statutory criterion which must be met before claims 1 and 30 may be rejected as anticipated, namely that "the invention" be "patented or described in a printed patent."

Then, in step 35, Kimoto '154 states that,

> "the scale value from the scale translation section 17 is compared

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[30]   Kimoto '154, column 4, lines 4-6.

[31]   Kimoto '154, column 3, line 4.

by the comparator 19 with the count of the counter 16." [32]

In contradistinction, claims 1, 3 and 30 rely upon the step of "jumping" by:

> "counting the number of tracks detected during said jumping step." [33]

Recognizing that Kimoto '154 relies upon "the overlap grating type detection method" [34] of optical scale 12 to gauge movement of linear motor 11, this reference has neither reason to practice, nor teaching of, Applicant's step of "counting the number of tracks" as is erroneously stated in Paper No. 5.

In conclusion, rejection of claims 1, 3 and 30 is not improper and should be withdrawn, together with allowance of newly presented claims 31 through 46, in recognition of the foregoing omissions in Kimoto '154. It is significant that Kimoto '154 is concerned with calibration of optical scale 12, rather than calibration of its control section 21; consequently, the process steps detailed in Figures 2A, 2B of Kimoto '154 are directed to different operations that may not be read as anticipating any of claims 1, 3 or 30, or any of newly presented claims 31 through 46. Withdrawal of the anticipation rejection and the allowance of these claims is respectfully requested.

Allowable Subject Matter

The Examiner stated that claims 2, 4 and 5 would be allowable if rewritten in independent form including all of the limitations of the rejected base claim and any intervening claims, and if the rejection under 35 U.S.C. §251 is overcome. The Examiner further stated that claims 6 through 29 would be allowable if the rejection under 35 U.S.C.

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[32]   Kimoto '154, column 4, lines 4-6.

[33]   Claims 1, 3 and 30, third paragraph.

[34]   Kimoto '154, column 3, line 4.

§251 is overcome.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

A fee of $718.00 is incurred by addition of five (5) independent claims in excess of total 4, and sixteen (16) total claims in excess of total 30. Also, a fee of $110.00 is incurred by the filing of a petition for a one month extension of time. Applicant's check in the amount of $828.00 drawn to the order of Commissioner accompanies this response. Should the petition become lost, the Commissioner is requested to treat this paragraph as a petition for an extension of time, and should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P56169RE
Date: 7/22/04
I.D.: REB/kf